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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,693	01/22/2004	Romain Pillard	945-011666-US (PAR)	5263
2512	7590	08/23/2007	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			OSELE, MARK A	
			ART UNIT	PAPER NUMBER
			1734	
			MAIL DATE	DELIVERY MODE
			08/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/762,693

Applicant(s)

PILLARD, ROMAIN

Examiner

Mark A. Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 3 and 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08). Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413). Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5, 9, 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent Publication 5-32231 (Tetsuya et al.). Tetsuya et al. shows a mail item feed module comprising a separator, 61, for separating envelope flaps from envelope bodies wherein the active zone of separation is supplied in the form of elastic mylar. The English language abstract of the reference fails to disclose whether the mail item feed is part of a franking machine. Even if the apparatus of Tetsuya et al. is not part of a franking machine, it would have been obvious to one of ordinary skill in the art to use the feed module of Tetsuya et al. in a franking machine because machines that fill, seal, address, and add

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postage to envelopes all in one device are conventionally used because they are efficient.

Regarding claim 2, the edge of the supply part is arranged at the level of an envelope conveyor deck (See Figs. 10-12).

Regarding claim 5, Tetsuya et al. appears to show the separator to have a circular open end (See Fig. 11) for accommodating a rod which would be a rigid part of the separator. Even if the circular open end of Tetsuya et al. is not connected to a rod, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the open end of Tetsuya et al. over a rigid rod for connection to the frame of the apparatus.

Regarding claims 9 and 10, the device of Tetsuya et al. allows for moistening envelope flaps.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Publication 5-32231 (Tetsuya et al.) in view of either Whitener (U.S. 5,021,279) or Anderson et al. (5,922,591). As shown in paragraph 3 above, Tetsuya et al. shows the instantly claimed invention but fails to show the separator to comprise silicone.

Whitener (column 5, lines 20-24) and Anderson et al. (column 21, lines 38-52) each show that mylar and silicone are known equivalent flexible materials used in making three dimensional objects. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the mylar separator of Tetsuya

et al. with a silicone separator because Whitener and Anderson et al. each show the interchangeability of these two materials.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: any description of the configuration a separator would require to avoid jamming of the envelopes or any description of how the envelopes would jam if the flaps were improperly closed.

***Allowable Subject Matter***

7. Claims 3 and 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art suggests making the supple part of the separator overmolded plastic on a steel wire, connected to a rigid part by a slideway or rail, or articulated on a rigid part by a hinge.

### ***Response to Arguments***

9. Applicant's arguments filed June 14, 2007 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the definition of "separating envelope flaps from envelope bodies") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues that the envelopes in Tetsuya are loaded in an "open" configuration in that the flap is not folded to block the envelope opening. This analysis is correct, however, the claim does not clearly indicate what is meant by "separating envelope flaps from envelope bodies." The examiner has broadly interpreted "separating envelope flaps from envelope bodies" to include the procedure of Tetsuya wherein the envelope flap is distanced from the opposite side of the envelope so sheets of paper can be automatically inserted (See Fig. 12). As indicated above, limitations from the specification are not read into the claims.

Similarly, applicant's argument that claim 10 includes the limitation the "separator allows for moistening envelope flaps" has been interpreted that upon distancing the envelope flap from the envelope body a moistening element could moisten the envelope flap. Applicant appears to be reading limitations from the specification into the claims with the argument, "There is absolutely no disclosure whatsoever that the opening

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members of Tetsuya moisten envelope flaps.” Claim 10 includes the limitation “wherein the separator allows for the moistening of the envelope flaps” and not ‘wherein the separator moistens the envelope flaps.’

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

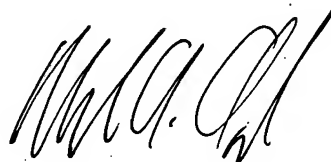
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**MARK A. OSELE**  
**PRIMARY EXAMINER**

August 20, 2007